

REMARKS

With the foregoing amendment claims 1-5, 7, 9, 11, 13-16, 18, 19 and 39-57 are pending in the application. Claims 1 and 40 are independent. No new matter has been added by the amendments. Applicants respectfully request reconsideration of the present application.

I. Claim Amendments

Claim 1 has been amended to incorporate the features of claims 6, 8, 12 and 17. Accordingly, Applicants respectfully submit that claim 1 is now in condition for allowance.

II. Claim Rejections Under 35 U.S.C. § 112

Claim 39 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. It is not clear to Applicants whether the Office is rejecting claim 39 for lack of “enablement” or for lack of “written description.” In any event, Applicants respectfully traverse the rejection.

Applicants submit that the invention defined by claim 39 is “enabled” and “supported” by the specification.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” M.P.E.P. § 2164.01 (emphasis added). The test is met in this case. It would not require undue experimentation for one to make or use the invention defined by claim 39. Claim 39 requires merely that the “trimming capacitances are each selectively connectable in series with each other.” Anyone (even a high school student) is capable of constructing a circuit so that the elements are connected in series. Thus, Applicants do not understand how the Office Action can seriously contend that the invention is not enabled. Furthermore, the Office Action does not even allege that one reasonably skilled in the art could not make or use the invention without “undue

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experimentation.” Accordingly, the Office Action fails to make a *prima facie* case of lack of enablement.

With respect to the written description requirement, Applicants respectfully submit that this requirement is met. “To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” M.P.E.P. 2163(I) (emphasis added).

In this case one skilled in the art can reasonably conclude that the inventor had possession of the invention defined by claim 39. Claim 39 modifies claim 1 by requiring that the trimming capacitances are each selectively connectable in series with each other. The Examiner notes that the drawings show the trimming capacitances connectable with each other in parallel. However, the specification states, “[t]he present invention ... provides a method for operating a variable frequency oscillator ... comprising: ... connecting that set of the trimming capacitances between the first node and the second node.” Page 6, second paragraph. The specification also states that the embodiments shown by the drawings are only by way of example. Id. (“The present invention will now be described by way of example, with reference to the accompanying drawings”). Accordingly, while there is no explicit statement that the trimming capacitances could be connected in series with each other, there is also no explicit statement that the trimming capacitances must be connected in parallel with each other. Thus, it is respectfully submitted that it would have been understood to a skilled person that the trimming capacitances could be connected in series or in parallel. That is, the skilled person would find no reason to assume that the capacitances could only be connected in parallel with each other. Thus, claim 39 is believed to be allowable.

III. First Claim Rejections Under 35 U.S.C. § 102

Claims 1-19 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Endo (US 6172576). Applicants respectfully traverse.

To overcome the rejection based on the Endo patent, Applicants submit herewith a Declaration under 37 C.F.R. § 1.131 (a.k.a., a Rule 131 declaration) signed by the inventors.

Attached to the Rule 131 declaration are copies of certain pages of a laboratory notebook kept by the inventors in connection with the development of the subject matter of the present application.

As explained in further detail in the Rule 131 declaration, the certain pages from the laboratory notebook demonstrate that the inventors acted with due diligence toward the reduction to practice of the claimed subject matter from a time prior to April 2, 1999 through July 19, 1999, the filing date of the priority application.

Thus, the Rule 131 declaration filed herewith establishes that the Endo patent is not a proper reference under 35 U.S.C. §102(e) because it was not “filed in the United States before the invention” of the subject matter of this application. Accordingly, applicants respectfully request withdrawal of the rejection of claims 1-19 under §102(e) based upon Endo.

IV. Second Claim Rejections Under 35 U.S.C. § 102

Claims 1, 3-6, and 11-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Martin et al. (US 5,686,864). Applicants respectfully submit that this rejection is now moot in view of the amendment to claim 1. Claim 1 has been amended to incorporate the features of claims 6, 8, 12 and 17. Because claim 17 has not been rejected in view of Martin and because the features of claim 17 have been incorporated into claim 1, claim 1 as currently amended is not anticipated by Martin.

V. Claim Rejections Under 35 U.S.C. § 103

Claims 7-10 stand rejected under 35 U.S.C. § 103 as being unpatentable in view of Martin. With respect to claims 8 and 10, the rejection is moot as claims 8 and 10 have been cancelled. With respect to claims 7 and 9, these claims depend from claim 1. Therefore, claims 7 and 9 are patentable for at least the same reasons give above with respect to claim 1.


VI. New Claims

Claims 40-57 are added. Claim 40 corresponds to claim 2 rewritten in independent form. Because Endo is not prior art and because claim 2 is neither taught nor suggested by Martin, claim 40 is in condition for allowance. Claims 41-57 are also in condition for allowance because they depend from claim 40.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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